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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,872	11/15/2000	Ralph W. Wright JR.	A148 1596	9345

7590 10/31/2003

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/712,872

Applicant(s)

WRIGHT ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-28 and 56-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-28, 60-62 and 64 is/are rejected.
- 7) ☒ Claim(s) 56-59, 63 and 65 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed August 4, 2003. Claims 6 and 14-27 were canceled, claims 1-3, 5-6, 8-12, 19, 23-25, 27, 56 and 57 were amended and claims 60-65 were added. Upon further consideration, the restriction requirement filed May 20, 2003 is withdrawn rendering claims 1-3, 5-28 and 56-65 pending

NONSTATUTORY DOUBLE PATENTING

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3 and 5-28 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-28 of copending Application No. 10/395297. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Specifically, they are not patentably distinct from each other because

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they both include a decorative floor covering comprising a substrate and a radiation cured pigmented topcoat disposed on the substrate having a stain resistance of about less than 150 Delta E units and a gloss retention of at least about 80%.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-10, 12-21, 23-28, 60-62 and 64 are rejected under 35 U.S.C.

103(a) as being unpatentable over Shalov et al. (U.S. 5,830,937) in view of Ehrhart et al (U.S. 5,543,232).

Shalov discloses a surface covering comprising a chemically or mechanically embossed substrate (column 19, lines 1-7), a UV light radiation cured pigmented intermediate wear layer and a UV light radiation cured topcoat which has high gloss values and excellent resistance to stains (Abstract and column 22, lines 31-34) where UV light curable pigment comprises ultraviolet light curable resin. Shalov discloses the topcoat and wear layer comprise polyester acrylates (column 10, lines 37-67). Shalov discloses that the surface covering further comprises a printed pattern in which the pigmented topcoat is in register with by indenting with the printed pattern (Figure 2). The reference discloses that the topcoat and intermediate wear layer are in register with the

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embossed texture of the substrate by indenting with the substrate (Figure 2) where the embossed substrate has raised surfaces and indentions and that the pigmented topcoat and intermediate wear layer are disposed on the raised surfaces and in the indentions.

Shalov does not disclose that the stain resistance is about less than 150 Delta E units (as in instant claim 1) or that the topcoat has a gloss retention of at least about 80% (as in instant claim 13). Ehrhart shows a floor covering comprising a substrate and a UV radiation cured acrylated polyester wear layer having a stain resistance of 2682 Delta E units and a gloss retention of 87%-93% (abstract and column 9, line 29 to column 10, line 6) where the substrate comprises a laminated film (column 9, lines 18-19). It would have been obvious to one of ordinary skill in the art to make the surface covering of Shalov with the stain resistance of less than about 150 Delta E units since it is known, as shown by Ehrhart, that radiation curable topcoat layers with such a strain resistance is desirable in floor coverings to prevent household stains from becoming permanent in the floor covering.

Claim Rejections – 35 USC § 103(a)

6. Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al. (U.S. 5,830,937) in view of Ehrhart et al (U.S. 5,543,232) further in view of Sawka et al. (U.S. 5,405,675).

Shalov and Ehrhart are relied upon as above for claims 1 and 12. Shalov does not disclose the nacreous pigments as in instant claims 11 and 22. Sawka teaches that

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pearlescent dyes (nacreous pigment) can be used in color layers of an embossed multilayered film (column 8, lines 5-14). It would have been obvious to one of ordinary skill in the art to use nacreous pigments in the pigmented topcoat of Shalov since it is known, as shown by Sawka, that various pigments such as nacreous pigments can be used to achieve a pearlescent color in the surface covering.

7. Claims 56-59, 63 and 65 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Examiner acknowledges Applicant's amendments to avoid the election/restriction requirement and the election/restriction requirement is withdrawn.

Rejection made under 35 USC 103(a) as being unpatentable over Ehrhart et al (U.S. 5,543,232) in view of Shalov et al. (U.S. 5,830,937) is withdrawn due to Amendments made by Applicant.

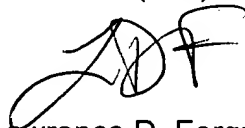
Rejection made under 35 USC 103(a) as being unpatentable over Shalov et al. (U.S. 5,830,937) in view of Ehrhart et al (U.S. 5,543,232) and over Shalov et al. (U.S. 5,830,937) in view of Ehrhart et al (U.S. 5,543,232) further in view of Sawka et al. (U.S. 5,405,675) are maintained because Applicant fails to provide arguments showing unobviousness for these rejections.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.


Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700